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Dan Kikinis

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EXAMINER

SALCE, JASON P

ART UNIT

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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/875,546 | Applicant(s) KIKINIS, DAN | |
| | Examiner Jason P. Salce | Art Unit 2421 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,9,13,14,17,21,22 and 25-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-6,9,13-14,17,21-22 and 25-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/01/2008 have been fully considered but they are not persuasive.

In regards to the 112 1st Paragraph rejection, Applicant argues that claim 2 of the original specification provides support for the currently claimed limitation, "**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG**".

The examiner disagrees and notes that original claims 1 and 2 differ in scope from the currently amended claim 1 of the instant application. For example, original claim 1 states "**a computing device coupled with**", as opposed to the currently claimed "**a computing device configured to**". Further, original claim 2 states, "**wherein the video display can display a portion of the EPG concurrently displayed on the second display of the computing device**", while the currently presented claim state, "**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG**". As shown, both claims differ in scope and therefore the original disclosure of the specification cannot be used to support the currently amended claims.

Applicant also notes that the original claims, in combination with the remaining original disclosure clearly provide support for the currently amended claims, however,

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Applicant's statement is purely speculative and the Examiner (**after examining the original disclosure numerous times in the previous responses to Applicant in defense of the 112 1st Paragraph rejection**) has not found support for the presently amended claims. If Applicant still feels that the original disclosure supports the presently amended claim limitations, the Examiner invites Applicant to specifically provide detailed evidence that the original disclosure provides such support.

The Examiner has noted the amended specification and the 101 rejection has been rescinded.

In regards to the 102 rejections in view of Grooters, Applicant argues that Grooters fails to teach displaying portions of the EPG on the two displays concurrently. The Examiner disagrees and notes that Column 7, Lines 24-27 clearly states that display 226 is used to display a portion of EPG 214. Further, while display 226 is displaying a portion of EPG 214 and the user highlights a time slot or channel on the portion of EPG 214 displayed on display 226 (**Column 7, Lines 27-31**), the **PROGRAM GUIDE DATA 214 corresponding to the highlighted time slot or channel (which clearly represents a SECOND PORTION of an EPG) may be transmitted to second information handling system 218 and displayed on a display 228**, rather than display 226, which has been noted as displaying a first portion of the EPG.

In regards to new claims 34-39, see the updated rejection below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-7, 9, 12-15, 17, 20-23 and 25-39 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The independent claims state, “**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG**”.

The examiner notes that although Paragraph 0033 of the instant application states, “***A user of the EPG displayed on computing device 105 may also, through input device 160, display portions of or the entire EPG on video display 105***”, this portion of the specification fails to specifically state that EPG is displayed concurrently on the computing device and the video display. There is no positive recitation that while an EPG is displayed on the computer device 105, the EPG may also be displayed on video display 105 **concurrently**. The specification only teaches that portions of an EPG can be displayed on either device.

Applicant has previously directed the examiner's attention to Paragraph 0008, which states that the EPG may be displayed on a display screen coupled to a computing device and additionally, the user may still display the EPG on the primary display if they so wish, however, Paragraph 0008 makes no such statement regarding the displaying of the EPG on both devices concurrently. The Applicant states, "The ability of the user to still display the EPG on the primary display if they so wish specifies that the EPG on the computing device and on the video display **may be** concurrently displayed". The examiner notes that the mere teaching of two video displays would not provide the ability for the EPG to **may be** concurrently displayed, however, in order to claim such a feature, the specification must explicitly teach the concurrent display of an EPG on both devices.

Further, new claims 34 and 37 further recite, "**wherein the computing device and the video display are configured such that the portion of the EPG displayed on the computing device is the same as the portion of the EPG concurrently displayed on the video display**". As discussed above, the specification fails to support displaying a portion of the EPG on a first display and a portion of the EPG on a second device concurrently, therefore the same portion of the EPG displayed on both devices concurrently cannot be supported.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, 12, 15, 17, 20, 23 and 25-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Grooters (U.S. Patent No. 6,862,741).

Referring to claim 1, Grooters discloses a video display configured to communication with a receiving system (**see Figure 3 and Column 6, Lines 26-35 for display 226 communicating with information handling system 100**) and to display a video broadcast (**see Column 6, Lines 26-35 for displaying a television program on display 226**).

Grooters also discloses a computing device configured to communication with the receiving system (**see handheld device 228 connected to information handling system 100 in Figure 3**), the computing device having a second display configured to concurrently display an Electronic Programming Guide (EPG) corresponding to the video broadcast (**see Figure 3 and Column 6, Lines 13-19**).

Grooters also discloses that the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG (**see Column 7, Lines 24-36 and claim 1 for highlighting a program guide entry on a first display and transmitting and displaying additional program guide information on a second display**).

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Referring to claim 9, see the rejection of claim 1.

Referring to claim 17, see the rejection of claims 1.

Referring to claims 25-27, see the rejection of claim 1 for displaying an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 28-30, Grooters discloses that the computing device is configured to transmit a signal to the receiving system corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while at least a portion of the EPG is displayed on the second display (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 31-33, see the rejection of claim 1 for display an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 34 and 37, Grooters discloses that the computing device and the video display are configured such that the portion of the EPG displayed on the computing device is the same as the portion of the EPG concurrently displayed on the video display (**see again Column 7, Lines 24-35 for teaching displaying time slots for programs (Figure 3) on display 226 and highlighting one of the time slots to**

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display further information on display 228 related to the highlighted time slot on display 226, therefore Grooters clearly teaches displaying two portions that are the same, because the data being displayed on both devices correspond to the same highlighted time slot).

Referring to claims 35 and 38, Grooters discloses that the computing device and the second display are further configured to display a preview of a broadcast program displayed in the EPG (**see again Column 7, Lines 24-35 for the first and second display devices 226 and 228 displaying time slots and program guide data related to the highlighted time slots, therefore displays 226 and 228 are clearly providing a preview (*the time and information related to the highlighted time slot*) of broadcast programs (*further note Figure 3 for the preview displayed on display 228*)).**

Referring to claims 36 and 39, Grooters discloses that the computing device and the video display are configured such that the preview of the broadcast program is displayed on the computing device concurrently while a separate broadcast program is displayed on the video display (**see Figure 3 and Column 6, Lines 13-33 for display 228 displaying previews for broadcast programs while display 226 is displaying an actual broadcast program).**

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 13-14 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grooters (U.S. Patent No. 6,862,741) in view of Ellis et al. (U.S. Patent No. 6,774,926).

Referring to claims 5-6, Nelson discloses all of the limitations in claim 1, but fail to teach that the computing device is a PDA or web phone.

Ellis discloses that a computing device can be a PDA or web phone (**see Column 6, Lines 23-27 and Lines 66-67 and Column 8, Lines 59-64**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the computing device, as taught by Grooters, using the PDA or web phone, as taught by Ellis, for the purpose of taking advantage of using devices that the viewer/user already owns to perform the various television control functionality.

Referring to claims 13-14, see the rejection of claims 5-6, respectively.

Referring to claims 21-22, see the rejection of claims 5-6, respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2421

Jason P Salce
Primary Examiner
Art Unit 2421

December 31, 2008